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EXAMINER

WHITE, C

ART UNIT

PAPER NUMBER

3713

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/339,076

Applicant(s)

Tracy et al

Examiner

Carmen White

Group Art Unit

3713

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on June 5, 2000
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-13 & 15-40 is/are rejected.
- ☒ Claim(s) 14 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Terminal Disclaimer

1. Applicant on page 6 of the response dated June 5, 2000, states that a terminal disclaimer has been filed with this response. However, there is no evidence in the record of the instant application that Applicant has filed a terminal disclaimer. Applicant must submit a terminal disclaimer in order for the non-statutory double patenting rejection to be removed from the record.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 & 15 & 33 & 36, 2-3 & 9 & 17-18 & 24, 4 & 19, 5 & 10 & 20 & 25, 16, 28, 29, 30, 31 and 32 are provisionally rejected under the judicially created doctrine of double patenting over claims 6 & 7, 9, 10, 12, 8, 13, 14, 15, 16, and 18, respectively, of copending Application No. 09/106,659. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: the steps of forming groups of entrants who have wagered on a first individual game and a second group participation game; determining the winners of both games at the conclusion of the games.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "the game" in line 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 further recites the following in the preamble of the claim "A method of playing a group participation wagering game in combination with an individual participation game..." and recites the following limitation in the body of the claim

"wherein the group participation game is independent of the individual participation game..." The preamble contradicts the newly added feature in the body of the instant claim. This makes the claim unclear.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 9-13, 15, 17-20, 24-31 and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II.

Regarding claims 1, 28, 30 and 36, Byrne discloses a group participation wagering game which includes the generation of a plurality of indicia that includes forming a group of game entrants who have made a first wager on the outcome of a first game {Keno} and a second wager on the outcome of a group participation game {Super Keno}; providing the group participation game such that an outcome of the game is based on matching a subset of the plurality of indicia which is common to the group (Fig. 3 shows the plural indicia that is common for all of the group); determining whether the group participation game is a winner; indicating the outcome of the group participation game; determining whether the first game is a winner (lines 1-12 of the abstract; col. 1, lines 38-43 and 57-64).

Applicant has added the new claim feature, wherein none of the entrants are allowed to select the subset of indicia, to claim 1. This feature is very broad and can be

interpreted in two ways. ***Examiner's First Interpretation:*** Byrne discloses a Keno game where the **actual** "winning indicia" are not selected by the entrants, but by the gaming authority. ***Examiner's Second Interpretation:*** Byrne discloses a group game of Super keno in which at least one of the entrants is allowed to choose the subset of "game play indicia" that entrant **expects** to be the winning indicia. As for the second interpretation, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Byrne to include the automatic selection of Keno numbers because it is well known in the art to provide the player with an option of allowing a computer to generate a random subset of "game play indicia". Allowing the random selection of the Keno numbers by an entity other than a group entrant would eliminate tension between the players of the group game, thereby making the game fair to all the players. Further the feature of none of the entrants being allowed to select the subset of indicia is taught in **bingo** gaming systems. Marnell II discloses a **bingo** game in a slot machine in which a plurality of players play a game of bingo together. The subset of bingo game indicia for the group game is chosen by a random computer selection (abstract and 5, lines 51-59). The random generation of a subset of indicia in which the player is not allowed to pick the indicia is well known in the slot machine gaming art in which the reels select indicia at random. This feature of Marnell II could have been easily incorporated in the electronic gaming machine of Byrne as the group game, because it is well known in the art to have multiple games on an electronic gaming machine. It is a matter of design choice as to what games are played on the electronic gaming machines.

Regarding claims 2-5, 9-10, 17-20, 24-25, 37-38, and 40, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne lacks disclosing the feature of randomly generating indicia in an array and comparing at least a portion of the array with a predetermined combination of indicia. Instead Byrne discloses a gaming system that includes Keno. In an analogous gaming system, Marnell II discloses a gaming machine that includes a poker game feature that performs the function of randomly generating indicia and comparing at least a portion of the array with a predetermined combination of indicia (Fig. 4, #62 and col. 8, lines 23-45). The art benefits from the random feature of Marnell II's teaching by making the gaming system less susceptible to cheating attempts. One skilled in the art would understand Marnell II's teaching as being a critical feature of poker type gaming devices. It would have been obvious to one of ordinary skill at the time of the invention to include random generation of indicia (poker machine) of Marnell II in the invention of Byrne to make a gaming device with multiple game features. This would increase the player's excitement for playing the gaming device.

Regarding claims 11 and 39, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne further discloses the feature of the entrants of a game being allowed to wager different amounts, and get paid an amount proportional to the amount wagered (col. 1, lines 36-67).

Regarding claims 12-13 and 26-27, Byrne in view of Marnell II discloses all the limitations of the claims as discussed above. Byrne lacks disclosing the feature of each game entrant wagering a fixed amount. It would have been obvious to a person of

ordinary skill in the art at the time of the invention to include the fixed wager feature as a matter of design choice. It is well-known in the gaming art to allow players to bet a fixed amount and receive an amount proportionate to the fixed amount as a payout.

Regarding claim 15, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. The references lack disclosing the group game and the individual game being independent of each other. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of allowing the games to be independent of each other in Byrne and Marnell II as a matter of design choice. It is well known in the electronic gaming art to allow players to play multiple games that are distinct from each other on one gaming machine. For instance, blackjack and draw poker are two independent games that can be programmed on a single gaming machine and played independent of one another.

Regarding claim 31, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne further discloses the feature of plural electronic gaming machines (Fig. 2 and lines 10-12 of the abstract).

Regarding claim 29, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Marnell II further discloses a bingo gaming system (Fig. 1, #47). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the bingo game feature of Marnell II in the system of Byrne because bingo gaming is well known in the art of electronic games.

8. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II, further in view of Koza et al.

Regarding claim 32, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne lacks disclosing a lottery game. Instead Byrne discloses a Keno game of chance. In an analogous game of chance system, Koza et al discloses a lottery game. It would have been obvious to a person of ordinary skill in the art to substitute the lottery game of chance of Koza et al in the place of the Keno gaming system of Byrne because lottery games are a well known form of chance games that generate high interest and player participation.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II, further in view of Weiss.

Regarding claim 16, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. The references lack disclosing the feature of forming a group of all winners of the individual participation wagering game. In the analogous gaming system of Weiss, players participate in a first and a second game. Weiss teaches the feature of forming a group of winners of a first individual game (col. 6, lines 24-39). The art benefits from this claim feature by providing a system that rewards a player's skill and judgment (Weiss- col. 2, lines 60-62). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the feature of forming a group of winners of Weiss in the gaming system of Byrne to increase consumer interest so that the gaming establishment can enjoy greater participation.

10. Claims 6-8 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Byrne in view of Marnell II, further in view of Barrie.

Regarding claim 6, 8, 21 and 23, Byrne in view of Marnell II discloses all the limitations of the claim as discussed above. Byrne and Marnell II lack disclosing the feature of multipliers on a slot machine wheel device. Barrie discloses the use of multiplier symbols on a simulated slot machine wheel display. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the multiplier feature of Barrie in the electronic gaming systems of Byrne and Marnell II in order to increase the amount of the payout to the players, thereby improving player participation at the gaming devices.

Regarding claim 7 and 22, Byrne in view of Marnell II, further in view of Barrie discloses all the limitations of the claims, as discussed above. While Byrne, Marnell II and Barrie disclose electronic gaming systems, the references lack disclosing the a mechanical wheel gaming device. It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ a mechanical wheel in the gaming machine invention of Byrne, Marnell II, and Barrie because it is well-known in the art of slot machines to use mechanical wheels, as a matter of design choice.

Allowable Subject Matter

11. Applicant's argument that the Byrne reference does not teach the claim feature of determining the outcome of the group game prior to determining the outcome of the individual game is persuasive. Therefore, claims 33-35 would be allowable **if** a terminal disclaimer is filed to overcome the double patenting rejection. Also, Claims 14 is

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objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner's Response to Applicant's Remarks

12. Claims 1 and 15, lines 7-8 and 10-11, respectively, recite "matching a subset of the plurality of indicia common to the group". Claim 36 recites "wherein the subsets of indicia are common to the entire group..." The examiner has interpreted this claim language to mean that the "indicia" is "common to the group", simply because of the way the claim language is written. Throughout Applicant's remarks, Applicant mentions that the references cited by the examiner in the claim rejections of the initial office action, dated March 1, 2000, lack disclosing the feature of "matching a common subset of indicia". However, the claim language is not written in the same format as described by Applicant in the remarks. Therefore, the examiner has considered the claim limitation as it has been written in the claims.

The preamble of claim 15 recites, "A method of playing a group participation wagering game in combination with an individual participation game..." However in the body of the claim, Applicant recites the limitation "wherein the group participation game is independent of the individual participation game..." in lines 12-13 of the claim. Applicant further argues that this claim limitation is not taught by Byrne. The claim language, as written is confusing to the examiner- because the preamble and body of the claim contradict themselves.

Applicant relies on the newly added claim features for patentability, and has argued for these features in the remarks. The examiner has addressed these features in the above office action.

Applicant further argues that the video poker game of Marnell II is an inherently individual game and is incompatible as the group game of the instant claims. Examiner disagrees. The instant invention, as broadly cited in the instant claims, read on the features of slot gaming system of Marnell II- as indicated in the above claim rejections.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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USPTO Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday-Friday, 8:30 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-308-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


Carmen White
Patent Examiner

August 9, 2000



**MICHAEL O'NEILL
PRIMARY EXAMINER**